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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/505,632 02/16/00 SCROGGIE

M 7791-0103-25

EXAMINER

WM01/0309

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ART UNIT

PAPER NUMBER

2163

DATE MAILED:

03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/505,632

Applicant(s)

Scroggie, et al

Examiner

Akiba Robinson-Boyce

Group Art Unit

2163



☒ Responsive to communication(s) filed on Jan 3, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24-49 is/are pending in the application.

Of the above, claim(s) 32, 33, 35, 44, 45, and 47 is/are ~~withdrawn from consideration~~ cancelled (O.A.B.)

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-31, 34, 36-43, 46, 48, and 49 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 28, 34, 40, 46, are rejected under 35 U.S.C. 102(e) as being anticipated by Sloane (US Patent 5,918,211).

As per claim 28, 34, 40, 46, Sloane discloses:

transmitting from a consumer computer.../means for transmitting from a consumer computer...(Col. 7, lines 5-10);

in response to receipt of said request at said Web site of said retailer.../means for, in response to receipt of said request at said Web site of said retailer (Col. 7, lines 13-22);

in response to receipt of said request at said remote site.../means for, in response to receipt of said request at said remote site...(Col. 7, lines 22-26);

in response to receipt of said manufacturers incentives.../means for, in response to receipt of said manufacturers incentives...(Col. 8, lines 3-7).

updating a manufacturers incentives database.../means for updating...(Col. 7, lines 36-40).

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The following is inherent with Sloane's invention because Sloane does disclose that the communication line of his invention can be an online computer network or the Internet (See col. 7, lines 18-22) and it is traditional practice to present data using a graphical user interface which presents graphical image data:

including graphical image data corresponding to said manufacturers incentives...

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-25, 27, 29, 36, 37, 39, 41, 48, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039).

As per claim 24, 36, 48, 49, Sloane discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request.../means for transmitting...in response to said request for manufacturer incentives, transmitting region data...means for, in response to said request...in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of

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said manufacturer at least one manufacturer incentive.../means for, in response to receipt of region data...(Col. 7, lines 5-26);

Sloane fails to teach the following, however Hoffman, et al discloses:

transmitting...at least one name.../means for transmitting...at least one name...(Col. 11, lines 1-9 read with Col. 13, lines 5-10);

It would have been obvious to one of ordinary skill in the art to transmit at least one name of the retailer and the manufacturer so the consumer will recognize which retailer and manufacturer should be used in order to get the desired incentives. This recognition would increase sales through those particular retailers and manufacturers.

As per claim 25, 37, Sloane fails to disclose the following, however Hoffman, et al discloses:

wherein said step of transmitting from said remote site said list further comprises transmitting a link.../wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 14, lines 64-67).

It would have been obvious to one of ordinary skill in the art to transmit a link to a Web site of at least one retailer so the request for products and incentives for a specific retailer can be sent to the correct location.

As per claim 27, 39, Sloane discloses:

transmitting from said consumer computer.../means for transmitting...(Col. 10, 3-7, col. 11, lines 47-48, col. 12, lines 4-8);

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Sloane fails to disclose the following, however Hoffman, et al discloses:

transmitting from said Web site of said manufacturer.../means for transmitting from said Web site...(Col. 6, line 46);

transmitting from said remote site to said Web site of said manufacturer details.../means for transmitting from said remote site...(Col. 6, lines 57-58);

transmitting from said Web site of said manufacturer to said client computer.../means for transmitting from said Web site of said manufacturer...(Col. 6, lines 62-63).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Hoffman, et al into Sloane because all of these additional steps are necessary for ensuring that significant details of manufacturer selection data are sent to the correct location.

As per claims 29, 41, Sloane discloses:

transmitting a user identification.../means for transmitting a user identification...determining manufacturer's incentives.../means for determining manufacturer's incentives...(Col. 9, lines 52-58, Claim 12, Claim 15).

5. Claims 26, 30, 31, 38, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloane (US Patent 5,918,211), and further in view of Hoffman, et al (US Patent 6,012,039) and Smolen (US Patent 5,915,243).

As per claims 26, 30, 38, 42, both Sloane and Hoffman, et al fail to disclose the following, however Smolen. discloses:

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determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying.../means for determining...transmitting from the client computer over the Internet to the Web site of the retailer region data.../means for transmitting...(Col. 2, line 66-Col. 3, line 9).

It would have been obvious to one of ordinary skill in the art to determine at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using region data, a database from a server of a remote Web site because by querying, all of the unwanted data can be filtered out of the search resulting in a quick, efficient way of obtaining desired incentive information.

As per claims 31, 43, both Sloane and Hoffman, et al fail to teach the following, however Smolen discloses:

wherein said region data is postal code data...(Col. 4, lines 64-67, where the examiner feels that the area code is analogous to the postal code).

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine if the retailer is in close proximity with the user resulting in a better match between the user and the retailer.

Response to Arguments

6. Due to the amended items presented by the applicant, the claim objections for claims 25, 27 and 39 and the 35 U.S.C 112 rejection for claim 25 has been withdrawn.

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7. Applicant's arguments with respect to claims 24-31, 34, 36-43, 46, 48, 49 have been considered but are moot in view of the new ground(s) of rejection.

The applicant's declaration filed 2/2/01 claiming that the applicant's invention was disclosed prior to May 13, 1997 has been reviewed and accepted. Therefore, the Allsop, et al. reference has been withdrawn. The new rejections are discussed above in paragraph #'s 1-5.

As per claims 24, 28, 36, 40, 48 and 49, the applicant argues that Sloane fails to teach a system where a consumer computer requests manufacturer incentives for purchase of goods or services from a retailer web site or a manufacturer Web site, forwarding the request to a remote Web site and transmitting the requested incentives to the manufacturer Web site or the retailer Web site which forwards the information to the consumer computer. The applicant argues that instead, Sloane merely teaches transmitting incentive information from a retailer or a manufacturer to a retailer computer for point-of-sale processing of incentives for consumers via wireless communications and a portable scanner device. However, the examiner believes that in combination with Hoffman, et al, the features of the present invention are disclosed. In Hoffman, et al, the PIA acts as the remote system of the present invention.

As per claims 34 and 36, the applicant argues that Sloane fails to teach updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data. However the examiner disagrees. In Col. 7, lines 36-38 teaches the 'updating' limitation. Also, as described above, the presentation of graphical image data corresponding to

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the manufacturers incentives is inherent to Sloane's system because Sloane does disclose that the communication line of his invention can be an online computer network or the Internet (See col. 7, lines 18-22) and it is traditional practice to present data using a graphical user interface which presents graphical image data.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

An inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba Robinson-Boyce whose telephone number is (703) 305-1340. The examiner can normally be reached on Monday-Friday from 6:30 AM-3:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3988.


An inquiry of a general nature or relating to the status of this application proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Akiba Robinson-Boyce

Patent Examiner

Group Art Unit 2163

March 5, 2001



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100